The opinion in support of the decision being entered today was <u>not</u> written for
publication and is <u>not</u> binding precedent of the Board.
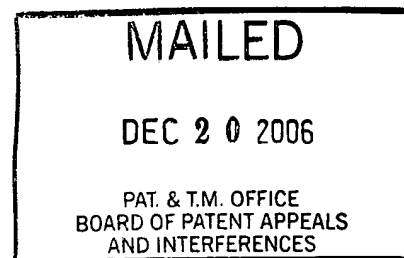
UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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<u>Ex parte</u> ALFRED T. TABAYOYON, RANDY L. PRAKKEN,
and GLENN F. WIDENER

_____

Appeal No. 2006-3433
Application No. 09/974,624

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ON BRIEF

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Before KRASS, JERRY SMITH, and BARRY, <u>Administrative Patent Judges</u>.

KRASS, <u>Administrative Patent Judge</u>.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 1-22.

The invention pertains to transmission of documents from one computer to

another computer. In particular, a verification is sent from the receiver computer that it

has successfully displayed the image of the received document in its browser window.

Representative independent claim 1 is reproduced as follows:

1. A method for transmitting a document from a sender computer to a receiver
computer via a computer network linking the sender computer and the receiver computer
to a server computer, wherein the sender computer is operated by a sender, wherein the
receiver computer is operated by a receiver, the method comprising the steps of:

a. generating a document file describing the document on the sender computer;

b. sending the document file from the sender computer to the server computer;

c. sending email to the receiver computer containing a hypertext link that the receiver activates to send a reference to the document file to the server computer;

d. sending the document file from the server computer to the receiver computer after the server computer receives the reference to the document file from the receiver computer;

e. processing the document file sent to the receiver computer to generate a display of an image of the document in a browser window on the receiver computer; and

f. sending verification data from the receiver computer to the server computer indicating that the receiver computer has successfully displayed the image of the document in the browser window.

The examiner relies on the following references:

Ohashi	6,209,030	Mar. 27, 2001 (filed Oct. 8, 1998)
Kurokawa	6,237,099	May 22, 2001 (filed Feb. 13, 1997)
Day et al. (Day)	6,243,722	Jun. 5, 2001 (filed Nov. 24, 1997)
Clark et al. (Clark)	6,266,703	Jul. 24, 2001 (filed Dec. 29, 1992)
Linden et al. (Linden)	6,360,254	Mar. 19, 2002 (filed Mar. 30, 1999)
McMillan	6,789,108	Sep. 7, 2004 (filed Aug. 8, 2000)

Claims 1-22 stand rejected under 35 U.S.C. §103. As evidence of obviousness,

the examiner offers McMillan, Linden, and Clark with regard to claims 1, 2, 4-8, 13-17,

and 21, adding, to this combination, Ohashi with regard to claims 9, 10, and 20,

Kurokawa with regard to claims 11, 12, 18, and 19, and Day with regard to claims 3 and

22.

Reference is made to the briefs and answer for the respective positions of

appellants and the examiner.

OPINION

Taking claim 1 as exemplary, the examiner contends that McMillan discloses

steps a-d of the claimed subject matter, but does not describe that the e-mail document

contains a hypertext link that the receiver activates to send a reference to the document

file to the server computer and does not describe that the server computer sends the

document file to the receiver computer to display the document (answer-page 4).

The examiner relies on Linden for embedding a hyperlink 74 in an email 72 for

the receiver 32 to request a document file 76, and for the server computer supplying the

document to the receiver computer 78. The examiner concludes that it would have been

obvious to combine McMillan and Linden "in order to provide a more secure method of

email viewing (i.e. disallowing executable programs to launch automatically upon

opening an email), which will reduce the likelihood of virus infection or unwanted

executing of scripts" (answer-page 4).

The examiner recognized that the McMillan/Linden combination did not disclose

that the receiver computer automatically returns verification data to the server computer.

The examiner then turned to Clark, referring to column 7, lines 5-25 therein, for a

teaching of automatically returning verification data to a server computer that the receiver

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computer has successfully displayed a document image. The examiner concluded that it would have been obvious to combine Clark with the other references "in order to insure that the users of McMillan were able to view the documents, instead of not viewing the advertisement embedded in the email, thereby making sure that the user accesses objects requested by an originator as supported by Clark (e.g. abstract; col. 1, lines 60-65) (answer-page 5).

Appellants admit that steps a-e of claim 1 are conventional (reply brief-page 5). What they claim as new is the notion of the receiver sending an acknowledgement back to the server after the receiver has received a document in response to activation of a hypertext link contained in the email and has successfully displayed the document described by the document file in a browser window (reply brief-page 5).

Since the McMillan/Linden combination admittedly does not perform such a function, the propriety of the rejection depends on Clark and whether it teaches this feature.

Appellants urge that Clark teaches a receiver computer sending an acknowledgement back to a server computer indicating it has successfully displayed a document, but that Clark's receiver does not acquire the document in response to activating a hypertext link conveyed in an email as recited in claim 1. Rather, Clark's server sends the receiver an email, but the email conveys not a hypertext link, but an attached "isochronous data object," as shown in Figure 2A of Clark (see page 5 of the reply brief).

We will sustain the rejection of claim 1 under 35 U.S.C. §103.

Appellants have admitted that steps a-e of claim 1 are conventional (reply brief-page 5). Step f recites "sending verification data from the receiver computer to the server computer indicating that the receiver computer has successfully displayed the image of the document in the browser window." At page 5 (lines 9-11 up from the bottom of the page) of the reply brief, appellants have also admitted that Clark teaches such a receiver computer sending an acknowledgement back to a server computer indicating it has successfully displayed a document. Thus, appellants base their contention of patentability on the receiver acquiring the document in response to activating a hypertext link conveyed in an email. However, sending a reference to the document file to the server computer based on activation of a hypertext link by the receiver, is step c of the claim and this has been admitted to be conventional by appellants.

Step f, relating to sending a verification from the receiver computer to the server computer indicating that the receiver computer has successfully displayed the image of the document in the browser window, recites nothing about any relationship of this verification to the activation of the hypertext link. Thus, we do not find persuasive appellants' argument regarding an acknowledgement sent back to the server after the receiver has received a document "in response to <u>activation of a hypertext link</u> contained in email..." (reply brief-page 5). We find no positive connection between the step c limitation of a receiver activating a hypertext link to send a reference to the document file to the server computer, and the step f limitation of sending verification data from the receiver computer to the server computer indicative of a successful display of the image of the document in the browser window of the receiver computer. In any event, there is no direct connection recited regarding the successful display of a document in the

browser window of the receiver computer and a hyperlink activation. That is, we find no requirement in the claim that the sending of an acknowledgement of a successful display of the document in the window browser of the receiver computer is "responsive" to activation of a hyperlink by the receiver computer.

As such, we find that the examiner has established a prima facie case of obviousness with regard to the subject matter of independent claim 1 which has not been successfully overcome by appellants via convincing argument. Since appellants do not separately argue the limitations of independent claim 14, this claim will fall with independent claim 1.

Thus, we will sustain the rejection of independent claims 1 and 14 under 35 U.S.C. §103.

Appellants argue that claim 2 is patentable because it recites the step of storing log data on the server indicating when the receiver returned the verification data, and that McMillan's Fig. 13, step 410, and column 9, lines 15-52, relied on by the examiner as teaching this, refers only to a client computer storing log data indicating when the receiver has returned verification data.

We will also sustain the rejection of claim 2 under 35 U.S.C. §103. Clearly, the teaching of a client computer storing log data indicating when a receiver has returned verification data suggests the storage of log data indicative of when a receiver has returned verification data. The skilled artisan is versed in the art enough to find it obvious to store this log data on either the server computer or the client computer. Thus, the storage of this log data on the server computer, rather than on the client computer, as taught by McMillan, would have been obvious, within the meaning of 35 U.S.C. §103.

Appellants argue that claim 13 recites "the receiver computer returns the verification data to the server computer as an encoded network address," whereas column 9, lines 15-52, of McMillan, relied on by the examiner, suggest nothing about a receiver computer returning verification data to the server computer regarding successful display of a document by the receiver computer, wherein the document is described in a document file delivered in response to activation of a hypertext link. Moreover, appellants contend that McMillan suggests nothing about any verification of any activity by any computer being transmitted to a server computer in the form of an encoded network address.

We will not sustain the rejection of claim 13 under 35 U.S.C. §103 because the examiner broadly refers to lines 15-52 of column 9 of McMillan, but it is unclear just what language the examiner relies on for the limitations of claim 13, especially, the language related to returning the verification data to the server computer by the receiver computer "as an encoded network address." The cited portion of the reference recites a program resident on the server for logging all functions of the content server and e-mail server, one of those functions being an "IP address of the user (recipient)," but it is not clear if this is what the examiner relies on. To the extent it is, it is not clear how this language suggests returning the verification data to the server computer by the receiver computer "as an encoded network address." Moreover, while appellants argue this limitation, the examiner has no response in the answer.

Accordingly, we are unconvinced that the examiner has established a prima facie case of obviousness with regard to the subject matter of instant claim 13.

With regard to claims 9, 10, and 20, the examiner adds Ohashi to the previous

combination in order to provide for a publish request (tag information) for preventing a

receiver computer from printing the document file. The examiner concluded that it

would have been obvious to use the "encapsulation" means of Ohashi in the

"encapsulation," or the bundling of information for distribution in various entities,

package of McMillan in view of Ohashi's secure encapsulation of HTML files such that

hard copying of files is denied, reducing the tendency of unauthorized users obtaining

classified or internal information as supported by Ohashi (column 2, lines 10-18) (see

page 8 of the answer).

Appellants argue that Ohashi prevents the printing of whatever is on the screen,

rather than preventing a document file from being sent to a printer, as claimed.

We will sustain the rejection of claims 9 and 20 under 35 U.S.C. §103 because we

find no evidence that Ohashi is limited to preventing printing of only the screen, as

argued by appellants. Ohashi clearly allows for the prevention of printing a hard copy of

a Web page displayed on a screen (column 5, lines 28-43). But that Web page may be

larger than the screen itself (as when scrolling buttons are employed). There is no

evidence in the disclosure of Ohashi that limits the copy prevention to only what is

shown on a screen at one time. The Web page is a "document" and it appears to us that if

such "document" is to be prevented from being printed, this means that the "document

file," as claimed, is prevented from being sent to the printer. It is true that Ohashi

employs "tag information" as an instruction as to whether or not to allow printing, but

even if this "tag information" is in an HTML file, it still keeps the document file from

being sent to the printer since the document file is prevented from being sent to the

printer if the appropriate tag information is present, and this appear to meet the language of the claims.

As to claim 10, appellants argue that step e of processing includes decompressing the document file to produce the print file and then processing the print file to generate the display of the image of the document in the browser window of the receiver computer, but that the examiner has not shown this limitation in the prior art (principal brief-top of page 12).

Since the examiner does not specifically address this claim language either in the rationale for the rejection or in response to appellants' arguments, it cannot be said that the examiner has established a prima facie case of obviousness. As such, we will not sustain the rejection of claim 10 under 35 U.S.C. §103.

We will sustain the rejection of claims 11 and 12 under 35 U.S.C. §103 since we determined supra that the examiner has established a prima facie case of obviousness with regard to independent claims 1 and 14 which has been unsuccessfully rebutted by appellants, and appellants rely on their argument regarding claim 1 to distinguish claims 11, 12, 18, and 19 from the prior art (see page 12 of the principal brief). Accordingly, these claims will fall with claims 1 and 14.

We will not sustain the rejection of claims 18 and 19 under 35 U.S.C. §103 because while appellants appear to rely on their arguments relative to claim 1 for patentability, claims 18 and 19 depend from claim 16, the rejection of which we have not sustained for reasons infra.

With regard to claims 7 and 16, the examiner never specifically addresses the limitations of these claims, but, rather, says that they are rejected "for similar reasons as

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stated above" (answer-pages 6 and 7) (Appellants argue the limitations of these claims at page 8 of the reply brief). Since we do not know what portions of the references the examiner relies on nor do we know the rationale for making the rejections, we will not sustain the rejection of claims 7 and 16 under 35 U.S.C. §103.

With regard to claim 8, appellants argue (page 8 of the reply brief) that this claim recites verifying the receiver is signed on to the server computer before transmitting the document file to the receiver computer. Our perusal of instant claim 8, as depicted in the appendix to appellants' principal brief, does not find such limitations. Claim 8 recites only that the step a of claim 1 comprises generating on the sender computer a print file for directing a printer to print the document, and processing the print file to generate the document file. Since appellants are arguing limitations not found in the claim, we will sustain the examiner's rejection of claim 8 under 35 U.S.C. §103.

With regard to claim 17, we will not sustain the rejection of this claim under 35 U.S.C. §103 because it depends from claim 16 under 35 U.S.C. §103, the rejection of which we have not sustained.

Since claims 3-6, 15, 21, and 22 have not been separately argued by appellants, and each of these claims depends from either independent claim 1 or independent claim 14, the rejections of which have been sustained, we will also sustain the rejection of claims 3-6, 15, 21, and 22 under 35 U.S.C. §103.

We have sustained the rejection of claims 1-6, 8, 9, 11, 12, 14, 15, and 20-22 under 35 U.S.C. §103 but we have not sustained the rejection of claims 7, 10, 13, and 16-19 under 35 U.S.C. §103.
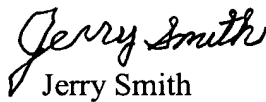
Accordingly, the examiner's decision is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal

may be extended under 37 CFR § 1.136(a)(1)(iv).
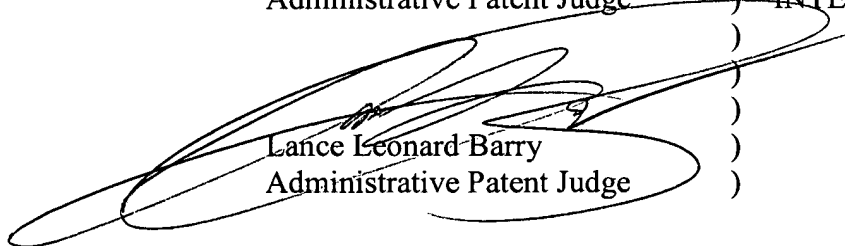
<u>AFFIRMED-IN-PART</u>

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Administrative Patent Judge   )
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Jerry Smith   )   BOARD OF PATENT
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